REMARKS

In this response, Claims 1, 4, 8, and 11 are amended. No claims are added or canceled. Thus, claims 1-6 and 8-13 are now pending in the application. The amendments to the claims as indicated herein do not add any new matter to this application. Each issue raised in the Office Action mailed July 13, 2009 is addressed below.

I. ISSUES NOT RELATING TO PRIOR ART

CLAIMS 1, 4, 8 AND 11 --- NON-STATUTORY DOUBLE PATENTING

The Office action at pages 2-4 rejects Claims 1, 4, 8, and 11 on the ground of non-statutory double patenting over U.S. Patent 7,464,020, in view of U.S. Pat. Pub. 2003/0004914 ("McGreevy"). In response, a proper terminal disclaimer and accompanying fee are submitted to overcome this rejection. Removal of this rejection is respectfully requested.

II. ISSUES RELATING TO PRIOR ART

A. CLAIMS 1 AND 8 --- 35 U.S.C § 103(a)

Claims 1 and 8 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent 7,249,121 ("Bharat"), in view of McGreevy and U.S. Patent 6,363,179 ("Evans"). This rejection is respectfully traversed.

Current Claim 1 recites the following (emphasis added):

> A computer-implemented method of displaying a compound word, the method comprising:
> receiving data that specifies a first form of a component word;

locating, within said compound word, a second form of said component word that differs from said first form of said component word; and
displaying said compound word with said second form of said component word visibly distinguished from the remainder of said compound word,
wherein the steps of receiving, locating and displaying are performed by a search engine executing in a computer system, and
wherein said compound word contains two or more component words.

Current Claim 8 is the computer-readable medium claim corresponding to current Claim 1.

Current Claim 1 includes the feature of "locating, within said compound word, a second form of said component word that differs from said first form of said component word." Additionally, current Claim 1 recites that a "compound word contains two or more component words."

As shown below, none of the cited references disclose or suggest locating, within a compound word, two or more component words. None of the cited references disclose or suggest any kind of "locating" step performed upon a compound word. Thus none of the cited references, and no combination of one or more references, discloses or suggests Applicants' claimed feature of "locating, within said compound word, a second form of said component word that differs from said first form of said component word."

The Office action at page 4 alleges states that Bharat:

> . . . discloses receiving data that specifies a first form of a component word (column 1 line 50-column 4 line 62 & column 6 line 40-54) performed by a search engine executing in a computer system (search engine);
> locating, within said compound word said component word (column 1 line 50-column 4 line 42 & column 6 lines 40-54) performed by a search engine executing in a computer system (search engine).

However, the quoted portions of Bharat: column 1 line 50 through column 4 line 62 and column 6 lines 40-54, as well as the remainder of Bharat, neither discloses nor suggests any form of a component word that is part of a compound word; instead, Bharat discloses treating multiple search terms as a "single compound unit" or simply as a "compound." Bharat at column 1 lines 50-52 and lines 58-60.

Bharat provides several examples of generating compounds from search terms, including:

1) parsing the search terms "baldur's gate download" into the compound "baldur's gate" (Bharat at column 1 lines 50-60); and
2) parsing the phrase "leaving the old country western migration" into compounds "the old country" and "western migration," and the search term "leaving." (Bharat at column 5 lines 34-50).

The scheme of Bharat thus involves taking multiple words and treating them as a single unit, which is very different from Applicants' claimed feature of "locating, within said compound word, a second form of said component word that differs from said first form of said component word," as Bharat contains no disclosure or suggestion of location of either component words or compound words. For example, given the compound word "firehouse," the scheme of Bharat would be unable to parse "firehouse" into "fire" and "house."

Adding McGreevy fails to cure the deficiencies of Bharat. The "keyterm search" described in the 7 pages of McGreevy identified by the Office action (corresponding to paragraphs [0097]-[0189]) appears to disclose the generation of words containing a particular word, without regard to whether any generated word comprises a compound word. For example, if the particular word is "rest," the generated list of words includes "restroom" (a compound word having component words "rest" and "room") and "interest" (not a

compound word, because "inte" is not a component word). See McGreevy at paragraph [0134] and accompanying table.

McGreevy's scheme thus generates words, without regard to the existence of compound words, wherein the generated words include a particular search string such as "rest" or "engage." Any generation by McGreevy of a compound word, that is a word that contains two or more component words, is merely a happy coincidence. Nothing in McGreevy discloses or suggests taking a compound word and picking out the compound word's component words. Thus nothing in McGreevy discloses or suggests "locating, within said compound word, a second form of said component word that differs from said first form of said component word," because the techniques of McGreevy involve word generation.

Thus even if Bharat and McGreevy were combined together, whose successful combination is doubtful given the wildly divergent teachings of Bharat and McGreevy, the combination of Bharat and McGreevy would be unable to perform any location of two or more component words from a compound word.

Finally, adding Evans to the mix would fail to remedy these deficiencies. While Evans may be able to display a search term appearing in a document, Evans does so without regard to component and compound words, and Evans would similarly fail to perform any location of two or more component words from a compound word.

Accordingly, as the combination of references fail to disclose or suggest at least the claimed feature of "locating, within said compound word, a second form of said component word that differs from said first form of said component word," Applicants respectfully submit Claims 1 and 8 are in condition for allowance.

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B. CLAIMS 2 AND 9 --- 35 U.S.C § 103(a)

Claims 2 and 9 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bharat, McGreevy, and Evans, and further in view of U.S. Patent 5,337,233 ("Hofert"). This rejection is respectfully traversed.

Regarding Claims 2 and 9, Claim 2 is dependent upon Claim 1, and Claim 9 is dependent on Claim 8. The addition of Hofert to the combination of {Bharat, McGreevy, Evans} fails to remedy the deficiencies of {Bharat, McGreevy, Evans} described above, and as the combination of Hofert and {Bharat, McGreevy, Evans} fails to read on Claims 1 or 8, the combination fails to read on Claims 2 and 9. Accordingly, Applicants respectfully request reconsideration and withdrawal of the obviousness rejection.

C. CLAIMS 3 AND 10 --- 35 U.S.C § 103(a)

Claims 3 and 10 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bharat, McGreevy, Evans, and further in view of U.S. Patent 6,729,882 ("Noble"). This rejection is respectfully traversed.

Regarding Claims 3 and 10, Claim 3 is dependent upon Claim 1, and Claim 10 is dependent on Claim 8. The addition of Noble to {Bharat, McGreevy, Evans} fails to remedy the deficiencies of {Bharat, McGreevy, Evans} described above, and as the combination of Noble and {Bharat, McGreevy, Evans} fails to read on Claims 1 or 8, the combination fails to read on Claims 3 and 10.

D. CLAIMS 4 AND 11 --- 35 U.S.C § 103(a)

Claims 4 and 11 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bharat, in view of Noble and Evans. This rejection is respectfully traversed.

Regarding Claims 4 and 11, Claim 4 recites the following (emphasis added):

A computer-implemented method of determining a position of a component word within a compound word, the method comprising:
determining a first stem word associated with said compound word;
determining a second stem word associated with said compound word;
based on a comparison between letters in said first stem word and said compound word, determining a first starting position;
based on a comparison between letters in said second stem word and said compound word, determining a second starting position;
determining, based on said first starting position and said second starting position, a starting position associated with said first stem word;
determining, based on said first starting position and said second starting position, an ending position associated with said first stem word; and
displaying said compound word with letters at and between said starting position associated with said first stem word and said ending position associated with said first stem word visibly distinguished from the remainder of said compound word,
wherein said compound word contains two or more component words.

Current Claim 11 is the computer-readable medium claim corresponding to current Claim 4.

As explained above regarding the rejection of Claim 1, Bharat fails to disclose or suggest either of Applicants' claimed steps of "determining a first stem word associated with said compound word" and "determining a second stem word associated with said compound word" because in Bharat multiple space-separate words are considered as one unit (called a "compound") that does not equate to Applicants' claimed "compound word." Similarly, Bharat discloses nothing related to stem words.

The addition of Noble fails to remedy this deficiency of Bharat. Noble discloses taking a word input as a stem word (such as "blood") and looking up all words that begin with that word. Thus, Noble teaches the determination of a compound word ("bloodhound") associated with a stem word ("blood"), which is very different from "determining a first stem

word associated with said compound word" and "determining a second stem word associated with said compound word."

The addition of Evans fails to cure these deficiencies, as Evans displays search terms without regard to stem words or compound words. Thus as the combination of Bharat, Noble and Evans fails to disclose or suggest all features appearing in Claims 4 and 11, Applicants respectfully request reconsideration and withdrawal of the obviousness rejection.

E. CLAIMS 5-6 AND 12-13 --- 35 U.S.C § 103(a)

Claims 5-6 and 12-13 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bharat, in view of Noble and Evans, and further in view U.S. Pat. Pub. 2005/033565 ("Koehn"). This rejection is respectfully traversed.

Regarding Claims 5-6 and 12-13, Claims 5-6 are dependent upon Claim 4, and Claims 12-13 are dependent on Claim 11. The addition of Koehn to {Bharat, Noble, Evans} fails to remedy the deficiencies of {Bharat, Noble, Evans} described above, and as the combination of {Bharat, Noble, Evans} fails to read on Claims 4 or 11, the combination fails to read on Claims 5-6 and 12-13. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection.

III. CONCLUSION

The pending claims not discussed so far are dependent claims that depend on an independent claim that is discussed above. Because each of the dependent claims include the limitations of claims upon which they depend, the dependent claims are patentable for at least those reasons the claims upon which the dependent claims depend are patentable. Removal of the rejections with respect to the dependent claims and allowance of the

dependent claims is respectfully requested. In addition, the dependent claims introduce additional limitations that independently render them patentable.

For the reasons set forth above, Applicants respectfully submit that all pending claims are patentable over the art of record, including the art cited but not applied. Accordingly, allowance of all claims is hereby respectfully solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a law firm check for the petition for extension of time fee is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,
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